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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/659,375      09/08/00      TAKAHASHI      T      1539.1002 RE

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MMC2/0213

EXAMINER

HENRY, J

ART UNIT

PAPER NUMBER

2872

DATE MAILED:

02/13/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/659,375

Applicant(s)

TAKAHASHI, TOMOWAKI

Examiner

Jon W. Henry

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☒ received in Application No. (Series Code / Serial Number) 08/858,560.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 17) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Reissue Applications*

1. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

(1) the declaration does not state the inventor is the sole inventor. See 37 CFR 1.63(a)

(4).

(2) the declaration refers to the attached specification when it appears the signed declaration was filed after the original application and should refer to the originally filed application.

2. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See *In re Weiler*, 790 F.2d 1581, 229 USPQ 673 (Fed. Cir. 1986).

Applicant asserts in item no. 7 of the declaration filed November 21, 2000, an error drafting claims 1 and 10 of the patent unduly narrowly, which error has been corrected in at least claim 27. However, claim 27, as well as all the other newly presented independent claims, are also narrower than any patent claims by at least the recitation of "dioptric" and none of the claims newly presented in reissue are purely narrower than any of the patent claims. That is, all newly presented claims include separate features from all of the patent claims. Additionally, no linking claim, allowable or otherwise, has been presented to indicate the inventions claimed in the patent have unity of invention with the inventions claimed in the claims newly presented in reissue. In fact, it appears the patentability of the claims newly presented in reissue and the

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patent claims, <sup>is</sup> in any, is related to the separate features of the inventions. The fact the common subject matter of the patent claims and claims newly presented in reissue do not appear to relate to an unclaimed allowable linking claim directed to the newly claimed subject matter minus the recitation of "dioptric" is emphasized by reference to the Fig. 7 embodiment of Suenaga et al that may anticipate or at least make obvious such subject matter newly claimed in reissue "but for" the recitation of "dioptric." Therefore, it appears the claims newly presented in reissue relate to subject matter "entirely distinct" from anything earlier claimed or attempted or intended to be claimed. See *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 675 (Fed. Cir. 1986).

Additionally, the original patent claims have not been changed at all, and therefore it appears any statutory error would have to relate to the claims newly presented in reissue.

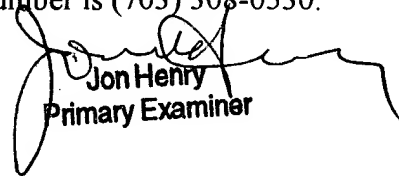
Applicant's statements in his declaration, including item no. 7, do not address how (1) the inventions newly claimed in reissue are not directed to "entirely distinct" inventions and therefore *Weiler* is not controlling case law with regard to finding applicant has failed to establish statutory error or (2) the inventions newly claimed in reissue are directed to "entirely distinct" inventions but *Weiler* is not controlling case law in this instance. Therefore, it appears applicants' declaration is defective for failing to establish statutory error under 35 USC 251 in accordance with *Weiler*. See *In re Weiler*, 790 F.2d 1581, \_\_\_, 229 USPQ 673, 677-678 (Fed. Cir. 1986).

Claims 1-57 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above.

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon W. Henry whose telephone number is (703) 305-6106. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0530.

  
Jon Henry  
Primary Examiner

jwh  
February 9, 2001